

10D



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,231	02/09/2004	Tadashi Katayama	Q79581	8874

23373 7590 07/14/2004
 SUGHRUE MION, PLLC
 2100 PENNSYLVANIA AVENUE, N.W.
 SUITE 800
 WASHINGTON, DC 20037

EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/773,231	Applicant(s) KATAYAMA ET AL.	
	Examiner Emily Bernhardt	Art Unit 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 9-11 is/are rejected.
- 7) ☒ Claim(s) 6-8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/011269.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/9/04</u> . | 6) <input type="checkbox"/> Other: ____. |

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-4, 9-10, drawn to pyridazinones where Q= Q-2 having Z1 as S or N and n=1, classified in class 544, subclass 58.5,354;class 504 subclass 221,etc.
- II. Claims 1-10, drawn to pyridazinones where Q=Q-2 when n=0 and Q3-Q5, classified in class 544, subclass 238;class 504 subclass 238.
- III. Claim 11, drawn to hydrazones, classified in classes such as 544, 548,549, subclasses various .

Note that the above restriction has been compacted to include Q-2 when n=0 as part of group containing Q3-Q5.

If group III is elected applicants must further elect a specific Q group as was done for I-II. An election of a single species embrative of the elected group is also required.

If no art is found for the final product group elected, the examiner indicated that corresponding hydrazones in Group III will also be examined.

The inventions are distinct, each from the other because of the following reasons: Compounds of I-II are drawn to a variety of Q-substituted compounds which are separately classified and are not art-recognized equivalents in the prior art. Thus art which may be pertinent to one of the groups may not necessarily be applicable to

remaining product groups. Intermediates of III are not coextensive with product groups and thus only make CF₃-substituted derivatives and require a separate search for patentability consideration.

During a telephone conversation with Mr. Landsman on 7/6/04 a provisional election was made with right of traverse to prosecute the invention of II (originally numbered as III), claims 1-10 and in particular the species of eg. 3-139.

Affirmation of this election must be made by applicant in replying to this Office action. Claim 11 is initially withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Since no prior art was found teaching or suggesting the structural makeup of products elected, the corresponding hydrazones of claim 11 have been searched based on species exemplified.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The abstract of the disclosure is objected to because it does not convey a structural makeup for formula (I) compounds being claimed. Correction is required. See MPEP ' 608.01(b).

The disclosure is objected to because of the following informalities: Status of parents should be updated in the specification on p.1. Appropriate correction is required.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Method claim 10 recites specifically controlling “unfavorable weeds”. How does this scope differ from treating “weeds” per se?

Claims 1-5, 9-11 are rejected under judicial doctrine as being drawn to an improper Markush group. The Markush at Q in Groups I-III embraces more than one invention as discussed in the restriction requirement set forth above. Deletion of nonelected subject matter would overcome this rejection.

Claims 6-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The art made of record is cited to show the state of the art. Note in US'218 similar subject matter is being claimed corresponding to Q-2 having 6-membered hetero rings. Commonly assigned US'891 which describes hydrazones claimed herein has a later effective filing date and claims therein are drawn to differing subject matter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is (571) 272-0664.

If attempts to reach the examiner by phone are unsuccessful, the supervisor for AU 1624, Dr. Mukund Shah, can be reached at (571)272-0674.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.



EMILY BERNHARDT

PRIMARY EXAMINER

Group 1600